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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,611	06/23/2003	Kinya Aota	503.35255V12	9607

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EXAMINER

JOHNSON, JONATHAN J

ART UNIT

PAPER NUMBER

1725

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/600,611

Applicant(s)

AOTA ET AL.

Examiner

Jonathan Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 08/820231.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Midling et al. (WO 95/26254). Midling et al. teaches a structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figures 5a-5e). A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter it becomes obvious to one of ordinary skill in the art to have the most aesthetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles. The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (5,460,317) of the IDS. Thomas et al. teaches a structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figures). A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter it becomes obvious to one of ordinary skill in the art to have the most aesthetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles. The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

Claim 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over The 2nd International Forum of Aluminum Ships of the IDS. The International Forum teaches a structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figure 4)', and a vehicle, comprising: a first plate and a second plate welded from one side, at a

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welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said vehicle (Figure 4 and the title). A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter it becomes obvious to one of ordinary skill in the art to have the most aesthetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles. The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

Claim 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welding & Metal Fabrication of the IDS. Welding & Metal Fabrication teaches a structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figure 1), and a vehicle, comprising: a first plate and a second plate welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a

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side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said vehicle (Figure 1 and page 4, column 1). A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter is becomes obvious to one of ordinary skill in the art to have the most aesthetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles. The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bulletin 6 Of the IDS. Bulletin 6 teaches a structure body comprising: A structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figures 3-4 and page 3, column 3): and a vehicle, comprising: a first plate and a second plate welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said vehicle (Figures 3-4 and page 3, column 3). A friction stir weld will have the same strength whether it is facing toward or away

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from something. When orientation does not matter is becomes obvious to one of ordinary skill in the art to have the most ascetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles. The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Childress (5,862,975). Childress teaches a structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figures 1-2,. column 1, lines 13-18,. column 2, Lines 39-51 and claim 2),. and a vehicle, comprising: a first plate and a second plate welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged at an outer face of said vehicle (Figures 1-2,. column 1, lines 13-18, column 2, Lines 39-51 and claim 2). A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter is becomes obvious to one of ordinary

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skill 'in the art to have the most ascetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles. The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally Limit the article. The applicant has failed to establish a frame of reference for the outer face.

***Allowable Subject Matter***

Claims 1-6 are allowed.

***Response to Arguments***

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., where the outer face of the railway as viewed from the inside of the railway car) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues a railway car "having an inside and outside, would have had an outer surface located (exposed) to the outside." The examiner agrees. Applicant, however, does not claim the outer face of the railway car as viewed from the inside of the railway car. During patent examination, the pending claims must be "given the broadest reasonable interpretation." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05,



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162 USPQ 541, 550-51 (CCPA 1969). In the instant case, DICTIONARY.COM defines "outer" as "farther than another." In applying the Prater test by giving the claims its broadest reasonable interpretation, the examiner interprets the "outer" surface or face to be any side of the railway car. For example, from the perspective of the person inside the railway car, the outer surface is the outside of the railway car. This is because the outside of the railway car is the farthest from the person. In another example, however, from the perspective of a person outside of the railway car, the outer surface is the inside of the railway car. This is because the inside of the railway car is the farthest from the person standing outside of the railway car.

Applicant argues the prior art does not teach "a raised portion connected to said welding portion" as required by claims 7 and 8. The examiner disagrees. It is noted that the features upon which applicant relies (i.e., a raised portion is located at the weld joint) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, it is the examiner's position that Midling teaches the claimed limitation at figure 5a-5e, where the raised portion is the protruding portion of the workpiece. Similarly, the Welding and Metal Fabrication and International Forum on Aluminum Ships also teach a raised portion on the workpiece.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

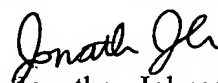
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Johnson whose telephone number is 571-272-1177. The examiner can normally be reached on M-Th 7:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jonathan Johnson  
Primary Examiner  
Art Unit 1725

jj